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Reed Smith LLP P.O. Box 488 Pittsburgh, PA 15230				
EXAMINER				
FELTEN, DANIEL S				
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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7 *Ex parte* TERRY ERISMAN
8
9

10 Appeal 2011-002091
11 Application 09/560,203
12 Technology Center 3600
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17 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and
18 MEREDITH C. PETRAVICK, *Administrative Patent Judges*.
19 FETTING, *Administrative Patent Judge*.
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21 DECISION ON APPEAL
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23
24

STATEMENT OF THE CASE¹

Terry Erisman (Appellant) seeks review under 35 U.S.C. § 134 of a final rejection of claims 1-10, 37-70, 76 -81, 85-87, and 94-102², the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

The Appellant invented a way of performing automated auctions by bidding on items that are somewhat mutually exclusive, and/or performing those types of auctions which are resolved on a collective basis with reference to more than one demand constraint provided in a bid (Specification 1:6-9).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

1. A method of processing bid information for an electronic auction comprising the steps of:

(a) providing a database of items available for auction;

(b) receiving a set of bids

from one or more bidders

for a corresponding set of items

selected from said database,

each bid in said set of bids including at least

a bid price

¹ Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed October 3, 2007) and Reply Brief ("Reply Br.," filed December 2, 2009), and the Examiner's Answer ("Ans.," mailed October 2, 2009).

² The rejection states that claims 1-102 are rejected, but claims 11-36, 71-75, 82-84, and 88-93 are cancelled.

1 and
2 a bid ranking
3 [both] specified by a bidder for an item;
4 [b-1] wherein said bid ranking from said bidder for an item
5 represents a desired order in which
6 a bid is to be resolved in the electronic auction
7 compared to
8 any other bids made by such bidder
9 for other items in said database of items;
10 [b-2] further wherein said bidder can specify
11 that a set of ranked bids
12 submitted by such bidder for a set of items
13 should be treated as mutually exclusive,
14 such that the electronic auction determines at most a
15 single item
16 to be awarded to said bidder
17 from said set of ranked bids
18 by correlating a ranking relationship between
19 separate items bid on by said bidder.

20 The Examiner relies upon the following prior art:

Barzilai	US 6,012,045	Jan. 4, 2000
Mori	US 6,044,363	Mar. 28, 2000
Aggarwal	US 6,151,589	Nov. 21, 2000
Godin	US 6,266,652 B1	Jul. 24, 2001
Lange	US 6,321,212 B1	Nov. 20, 2001

21 Claims 44-65 and 85-87 stand rejected under 35 U.S.C. § 101 as directed
22 to non-statutory subject matter.

Claims 1-10, 37-70, 76 -81, 85-87, and 94-102 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Mori, Barzilai, Godin, Aggarwal, and Lange.

The Appellant has decided not to contest the final rejection of claims 44 - 70 and 85 – 87 and has directed them to be cancelled. Reply Brief filed February 24, 2009. According to 37 C.F.R. § 41.31(c) (2007), “[a]n appeal, when taken, must be taken from the rejection of all claims under rejection which the applicant or owner proposes to contest.” Because the Appellants have decided not to contest the final rejection of claims 44 - 70 and 85 – 87, and the Appellant has directed their cancellation, the Examiner should cancel these claims upon return of the Application.

Thus the only rejection remaining is as follows.

Claims 1-10, 37-43, 76-81, and 94-102 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Mori, Barzilai, Godin, Aggarwal, and Lange.

ISSUES

The issue of obviousness turns primarily on whether the applied references describe plural bids submitted and ranked by a single bidder.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to the Prior Art

1. None of the applied references describe plural bids submitted and ranked by a single bidder.

ANALYSIS

All of the independent claims except for claim 6 recite bidders submitting plural ranked bids. We are persuaded by the Appellant's argument that none of the references describe this. The Examiner has not shown this in the Answer, but instead invites us to piece together the Examiner's findings from plural Office actions ("A discussion was made of all the aforementioned prior art in office action dated May 16, 2003 and October 31, 2003 with motivations to combine aforementioned references.") Answer 6. This is improper procedure. We have reviewed all of the Examiner's Office actions and are unable to determine how the Examiner finds the references, particularly Mori and Barzilai, which appear to be where the Examiner's citing for this feature, describe this limitation. In particular, Barzilai's bid table is a ranking of different bidders' bids rather than a ranking by a single bidder. We find the Examiner failed to present a prima facie case.

As to claim 6, the Examiner presented no findings or response in the Answer and so has failed to present a prima facie case here as well.

CONCLUSIONS OF LAW

The rejection of claims 1-10, 37-43, 76-81, and 94-102 under 35 U.S.C. § 103(a) as unpatentable over Mori, Barzilai, Godin, Aggarwal, and Lange is improper.

DECISION

The rejection of claims 1-10, 37-43, 76-81, and 94-102 is reversed.

REVERSED

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